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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/802,273 | 03/17/2004 | Gustavo C. Rodriguez | 31162B | 4202 |

45867 7590 04/01/2005

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|---|---|
| ROYDS, LESLIE A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1614 | |

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/802,273 | RODRIGUEZ, GUSTAVO C. | |
| | Examiner | Art Unit | |
| | Leslie A. Royds | 1614 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1 is/are rejected.

7)☒ Claim(s) 1 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

**Claim 1 is presented for examination.**

This application is acknowledged as a continuation-in-part of both U.S. Patent Application No. 09/528,963 filed March 21, 2000, now U.S. Patent No. 6,765,002 and U.S. Patent Application No. 09/798,453 filed March 2, 2001, which is a continuation-in-part of both U.S. Patent Application No. 09/528,963 filed March 21, 2000, now U.S. Patent No. 6,765,002 and U.S. Patent Application No. 09/672,735 filed September 28, 2000, now U.S. Patent No. 6,511,970, which is a continuation-in-part of U.S. Patent Application No. 09/532,340 filed March 21, 2000, now abandoned.

### *Claim Objection*

Claim 1 is objected to for failing to define "EE" at its first occurrence in the claim. It is suggested that Applicant amend the claim to read the following:

---1. A hormonal regimen wherein at least one of the daily dosages comprises at least 0.5 mg of norgestimate and an estrogen component which does not exceed 35 mcg **ethinyl estradiol** (EE) equivalent.---

### *Specification*

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code at page 16, line 27 and at page 75, line 3 of the disclosure. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP §608.01.

The disclosure is objected to because of the following informalities:

(i) the status of U.S. Patent Application No. 09/528,963 referenced at page 1, lines 7-9 and 11-12 should be updated to reflect the status of this application as U.S. Patent No. 6,765,002;

(ii) the acronyms "OCP" and "HRT" at page 10, line 9 of the disclosure should be defined at their first occurrence in the specification;

(iii) the word "epithelial" is misspelled at page 11, line 22 and page 12, line 5 of the disclosure;

(iv) the box symbol following "IL-1" at page 16, line 30 of the disclosure and following "ER" at page 63, line 2 of the disclosure should be removed for clarity;

(v) the word "of" in the phrase "...in turn increase **of** the amount of TGF-β molecules..." at page 21, line 24 of the disclosure should be removed for clarity; and

(vi) the word "flavonoids" is misspelled at page 47, line 11, page 48, lines 9 and 26, and page 49, lines 10 and 25 of the disclosure.

Appropriate correction is required. Due to the length of the specification, the Examiner may not have identified all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

### *Claim Rejection - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being anticipated by Elliesen et al. (International Patent Application No. WO 97/11680; 1997).

Elliesen et al. teaches a pharmaceutical composition comprising an estrogen component, such as ethinyl estradiol and mestranol (5-15 mcg/day), estradiol and their esters, e.g. valerate, acetate, benzoate and undecylate (0.5-4 mg/day), estriol, estriol succinate, polyestriol phosphate (2-8 mg), estrone, estrone sulfate and conjugated estrogens (0.3-1.2 mg/day), in combination with a progestogen component, such as norgestimate (see Section "The Estrogen and Progestogen" bridging pages 14-15). The compositions disclosed by the reference are taught to be useful in hormone replacement therapy and allow for self-administration of successive doses of an estrogen and progestogen over a protracted period of time (p.6, lines 4-9). Such is considered by the Examiner to meet Applicant's requirement of a "hormonal regimen". Furthermore, the Examiner considers the reference to meet Applicant's requirement of "an estrogen component which does not exceed 35 mcg EE equivalent" because the reference expressly teaches 5-15 mcg/day of the estrogen component ethinyl estradiol.

The differences between the Elliesen et al. reference and the presently claimed subject matter lie in that the reference does not teach:

(i) the particular dosage amounts of norgestimate and estrogen component as recited in present claim 1.

However, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention

was made to a person having ordinary skill in the art to which said subject matter pertains because:

(i) Although the disclosure of Elliesen et al. does not expressly teach the particularly claimed dosage amounts of the present claim, the determination of the optimum dosage regimen of norgestimate and an estrogen component, such as ethinyl estradiol, would have been a matter well within the purview of one of ordinary skill in the art at the time of the invention. Such a determination would have been made in accordance with a variety of factors, such as the age, weight, sex, diet and medical condition of the patient, severity of the disease, the route of administration, pharmacological considerations, such as the activity, efficacy, pharmacokinetics and toxicology profiles of the particular compound employed, whether a drug delivery system is utilized and whether the compound is administered as part of a drug combination. Thus, the dosage regimen that would have actually been employed would have varied widely and, in the absence of evidence to the contrary, the currently claimed specific dosage amounts are not seen to be inconsistent with the dosages that would have been determined by the skilled artisan.

Furthermore, motivation to alter the dosage amounts of the components of the composition disclosed by the reference can be found also in Elliesen et al., who expressly states, "a fixed combination of an estrogen dosage and a progestogen dosage that is suitable for all menopausal women is impossible to design...one reason is the wide variation from individual to individual in the resorption rate which exists with all modes of administration except intravenous, which is not practiced in HRT...another reason why a fixed combination is not suitable is because of variations in body weight and fat mass proportion...A third reason is the interaction between estrogens and progestogens, i.e., progestogens may only become effective in

the presence of estrogens because they stimulate the production of progestogen receptors" (page 2, para.4). In light of these reasons, it would have been well within the purview of the skilled artisan to alter the dosages taught by Elliesen et al. in order to enhance the efficacy of the hormonal regimen in producing a therapeutic effect in a particular subject.

***Double Patenting***

**Obviousness-Type**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Provisional**

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 34, 37 and 44 of copending U.S. Patent Application No. 09/754,732. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the presently claimed subject matter and the subject matter of the copending claims are the following:

(i) the copending claims recite that norgestimate is a progestin product (see copending claims 21 and 34, for example), while the present claim is silent as to norgestimate being a progestin product; and

(ii) the copending claims recite a ratio of dosages of progestin to estrogen of greater than 239:1 by weight in norethindrone/ethinyl estradiol equivalent doses (see copending claim 21, for example) or 100:1 by weight in norethindrone/ethinyl estradiol equivalent doses (see copending claim 37, for example), while the present claim recites a dose of 0.5 mg norgestimate and a dose of an estrogen component not to exceed 35 mcg ethinyl estradiol (EE) equivalent.

However, to the skilled artisan, the presently claimed subject matter would have been obvious because:

(i) regardless of the way it is identified, norgestimate is used as a primary active component of the composition of the present claim and the copending claims and, thus, is present in both the composition of the present claim and the composition of the copending claims; and

(ii) the determination of the optimum dosage ratios of progestin to estrogen would have been a matter well within the purview of one of ordinary skill in the art at the time of the invention. Such a determination would have been made in accordance with a variety of factors, such as the relative strength of the progestin or estrogen components, the age, weight, diet and medical condition of the patient, the route of administration and pharmacological considerations, such as the activity, efficacy, pharmacokinetics and toxicology profiles of the particular compound employed. Thus, the dosage ratios of the progestin and estrogen components would have been reasonably expected to vary and the amounts recited in the present claim would not be

outside the scope of what would have been determined by the skilled artisan from the copending claims.

Claim 1 of the present application is not considered to be patentably distinct from copending claims 21, 34, 37 and 44 of U.S. Patent Application No. 09/954,082 and is provisionally rejected under obviousness-type double patenting.

***Conclusion***

Rejection of claim 1 is deemed proper.

No claim of the present application is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (8:30 AM-6:00 PM), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leslie A. Royds
Patent Examiner
Art Unit 1614

March 30, 2005

RAYMOND HENLEY III
PRIMARY EXAMINER
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